RESPONSE TRANSMITTAL AND FEE AUTHORIZATION

ATTORNEY DOCKET NO.: 5058/70001	SERIAL NO.: 09/082,127	
FILING DATE: May 20, 1998	Confirmation No: 2348	**EXAMINER:** King Y. Poon	**GROUP ART UNIT:** 2624

INVENTOR(S): Takenori IDEHARA

TITLE OF INVENTION: INPUT-OUTPUT APPARATUS SELECTING METHOD FOR NETWORK SYSTEM

Mail Stop Appeal - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTED HEREWITH FOR THE ABOVE IDENTIFIED
PATENT APPLICATION IS:

- ☐ (A) A response to the Office Action dated:
- ☐ (B) A Petition for Extension of Time
  - ☐ for 1 month ☐ for 2 months ☐ for 3 months;
  - A Petition for Extension of Time, having been previously filed,
  - ☐ for 1 month ☐ for 2 months ☐ for 3 months
- ☐ (C) A request for approval of proposed drawing changes.
- ☐ (D) A Notice of Appeal. $
- ☒ (E) An Appellant's Brief on Appeal. $320.00
- ☐ (F) Other: . $
- ☐ (G) A verified statement to establish small entity status under 37 CFR §§ 1.9 and 1.27
- ☐ Small entity status under 37 CFR § 1.27 has been previously established

☐ The claims fee, if any, has been calculated as shown below

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May 21, 2003
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Date of Deposit
Brian E. Harris
Name of Applicant, Assignee, or Registered Representative

_____
Signature
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Technology Center 2600

	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	SMALL ENTITY			LARGE ENTITY	
					RATE	ADD'L FEE		RATE	ADD'L FEE
TOTAL		MINUS			x $9	$	OR	x $18	$
INDEP.		MINUS			x $42			x $84	
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ $140			+ $280	
					TOTAL ADD'L FEE	$ 0.00		TOTAL ADD'L FEE	$ 0.00

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  - ☐ the amount of $ for the claims fee calculated above AND/OR
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May 21, 2003
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Docket No. 05058/70001

/403

#27
5-30-05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re:

U.S. Application of:	Takenori IDEHARA
For:	INPUT-OUTPUT APPARATUS SELECTING METHOD FOR NETWORK SYSTEM
Confirmation No.:	2348
U.S. Serial No.:	09/082,127
Filed:	May 20, 1998
Group Art Unit:	2624
Examiner:	King Y. Poon

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MAIL STOP APPEAL - PATENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

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BRIEF ON APPEAL

Real Party in Interest

The real party in interest in the present Application is Minolta Co., Ltd., a corporation of Japan, having an office at Osaka Kokusai Building, 3-13, 2-Chome, Azuchi-Machi, Chuo-Ku, Osaka-Shi, Osaka, Japan 541-8556.

Related Appeals and Interferences

There are no related appeals or declared interferences which will directly affect or be directly affected by the present Application to the knowledge of the undersigned.

Status of Claims

Claims 9-22, 25-27, 33-35, 37-41, and 56-59 are the subject of this appeal. No other claims are pending. Claims 1-8, 23, 24, 28-32, 36, and 42-55 have been cancelled.

Status of Amendments

No amendments were filed by Appellant in response to the Office Action of December 17, 2002.

Summary of Invention

In general, the invention relates to a method, as well as a program, for providing a display that allows a user to connect to an input-output apparatus over a network. In some embodiments (e.g., embodiments 1-10), the user is provided a display of a layout diagram (or map) representative of a place of business, for example, showing walls, doors, tables, and the like. The layout diagram includes selectable symbols, such as icons, which are representative of input-output apparatuses, and which are positioned on the layout diagram according to respective installation locations in the place of business.[1] The user can set an apparatus to be used, for instance as an output destination, by selecting the corresponding symbol on the layout diagram.[2]

In some embodiments (e.g., embodiments 3-10), the user can control which input-output apparatuses are displayed on the layout diagram. For example, as shown in Fig. 18 (fourth embodiment), a selection box is displayed that allows a user to select between

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[1] *See, e.g.,* Specification, page 22, line 19 –page 23, line 5 and Fig. 6.

[2] *See, e.g., Id.* at page 27, line 15 –page 28, line 19 and Fig. 8.

"PRINTERS", "FACSIMILES", "SCANNERS", and "ALL TYPES". Fig. 19 shows the result of a user selecting "SCANNERS". In Fig. 19, it will be noted that not only are scanners A and B shown, but a fax machine and copy machines A and B are shown as well. This is because the fax machine and the copy machines A and B are also capable of functioning as a scanner, and therefore meet the criteria for being displayed. Information is provided that the fax machine and the copy machines A and B capable of functioning as a scanner from a table such as the one shown in Fig. 21.[3]

In another example, shown in Fig. 28 (sixth embodiment), a layout diagram is provided with a similar selection box, but in this embodiment the user can select between apparatuses having a paper output function, apparatuses having a bitmap saving function, and apparatuses having paper output and/or bitmap saving functions. Fig. 28 shows the layout diagram once the user has selected to view apparatuses having a paper output function, and, as a result, printers A, B, and C, copy machines A and B, and a fax machine are shown. Fig. 29 shows an example of the layout diagram once a user has selected apparatuses having a bitmap saving function, resulting in the display of scanner B, computers B and C, and a p.c. server. The functionality of the various apparatuses is provided from an apparatus information table.[4]

In some embodiments, such as the second embodiment, the layout diagram includes information related to the usability of each of the apparatuses as shown in Fig. 12 where the status of each printer is displayed below its respective icon. In this embodiment, software is provided to periodically check the status of each input-output apparatus update each respective status on the display. The display will display each apparatus and its status even if the power supply of the apparatus is turned off. As a result, the user will be provided a display of all of the input-output apparatuses, including those powered down, rather than only usable input-output apparatuses that are turned on.[5]

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[3] *See also* Specification, page 50, line 6 –page 51, line 3.

[4] *See also Id.* at page 61, line 23 –page 63, line 1.

[5] *Id.* at page 33, lines 4-24.

With regard to how the status is conveyed to the user, other options included in the text include varying the color of the icons based on apparatus status and displaying the apparatus status elsewhere in close proximity to the icon.[6]

The invention is not limited to displaying only a layout diagram of an office building. For example, according to the fifth embodiment, the user is provided a map of a geographical area showing places of business connected by a communication line of a wide area network (WAN) as shown in Fig. 26.[7] As illustrated by the hierarchical diagram shown in Fig. 25, the map of places of business in Fig. 26 is a top-level diagram of a plurality of levels of diagrams that a user can navigate to a bottom level diagram, where the user can select an input-output apparatus.[8] The user can select a destination place of business having the desired destination input-output apparatus on the map of places of business by clicking on a corresponding character string or display point associated with the desired destination.[9] The user is then provided a display of the building configuration associated with the selected destination place of business, such as the one shown in Fig. 27. The example shown in Fig. 27 is a configuration diagram of a building showing the floors of the building, each labeled with the name of its respective department.[10] The user can select an area corresponding to the desired destination floor having the desired destination input-output apparatus. The user is then provided a layout diagram, such as the one shown in Fig. 18 or Fig. 28, of the selected floor showing all of the input-output apparatuses. The user can then filter the view as described above to show apparatuses having only certain functions.[11]

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[6] *Id.* at page 32, lines 6-19.

[7] *See also Id.* at page 51, line 18 –page 52, line 2, page 53, lines 10-13, and Fig. 24.

[8] *See Id.* at page 52, lines 3-16.

[9] *See Id.* at page 54, lines 3-16.

[10] *See Id.* at page 55, lines 9-18.

[11] *See Id.* at page 56, lines 2-11 and page 56, line 20 –page 57, line 12.

The hierarchical levels are not limited to those discussed above with reference to the fifth embodiment. For example, the seventh embodiment provides an alternative layout diagram of a floor where, instead of a display of categories of functions being displayed as shown in Fig. 28, a plurality of icons are displayed representative of respective users as shown in Fig. 31. The user can select one of the displayed icons representing respective users to specify a user of an apparatus that is a desired destination apparatus.[12] Once one of the displayed users is selected, a layout diagram will be displayed showing only apparatuses that the selected user normally uses. The user can then select one of these displayed apparatuses as a destination apparatus.[13] Alternately, in a situation where the selected user has catalogued apparatuses in groups by function, the user can be presented a display of the groups by function for selection.[14]

The present invention is not limited to displaying the layout diagrams on a computer screen. For example, in the eighth embodiment, the layout diagram is provided to a user from a copy machine display, such as the one shown in Fig. 34, connected to a network, such as the one shown in Fig. 16.[15] A user can view the layout diagram shown in Fig. 34, where apparatuses having the function of printing are shown, by consecutively pressing the External Apparatus Specification key and the Print Key.[16] The display is a touch screen allowing a user to select an icon for a destination apparatus by pressing the appropriate area on the display.[17]

Fig. 40 shows an alternative layout diagram for the eighth embodiment to the layout diagram of Fig. 34, where in Fig. 40 apparatuses having the function of faxing are

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[12] *See Id.* at page 63, lines 8-13.

[13] *See Id.* at lines 17-23.

[14] *See Id.* at page 65, lines 7-12.

[15] *See Id.* at page 65, line 17 –page 66, line 5.

[16] *See Id.* at page 70, lines 18-20.

[17] *See Id.* at page 71, lines 10-22.

shown. Here, an additional feature of the present invention is also presented. Fig. 42 shows a flowchart for illustrating various steps in a process of substitute apparatus selection. As shown in Fig. 42, step 604, the process includes a step of judging whether the destination apparatus is in a state of being capable of outputting facsimile data.[18] When a judgment is made that the destination apparatus is not capable of outputting the facsimile data, an error message, 'Output Impossible', is displayed, as shown in Fig. 40, indicating that a selected destination apparatus, 'copy machine B', is incapable of outputting facsimile data.[19] A query, 'Transfer to Copying Machine A?', is also displayed regarding whether the facsimile data should be transferred to another apparatus having a faxing function.[20] In addition, an icon representing a possible replacement in closest proximity to the user is automatically selected by being displayed in an inverted state.[21] The user has the option of changing the automatically selected apparatus.[22] The user is made aware of available substitute apparatuses since the layout diagram, in addition to displaying the error message, displays all icons representing an output apparatus that can be used as a substitute apparatus for the apparatus in which the failure or error has occurred.[23]

As illustrated by Figs. 43-45, this process is not limited to selection of a substitute for output of facsimile data, but can be used for other functions such as printing as well.[24] In addition, while the process described above includes automatic selection of a substitute apparatus giving highest priority to an apparatus in closest proximity, a high priority can also be given to apparatus based on other criteria such as processing speed, such as

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[18] *See also Id.* at page 82, line 11 –page 83, line 20.

[19] *See also Id.* at page 78, lines 6-17.

[20] *See also Id.* at lines 17-20.

[21] *See Id.* at page 79, lines 6-10.

[22] *See Id.* at lines 18-20.

[23] *See Id.* at page 78, line 21 –page 79, line 2.

[24] *See also Id.* at page 87, line 16 – page 89, line 10.

printing and/or sorting speed.[25] Alternatively, the user can select a parameter to be used as a basis for prioritizing potential substitute apparatuses.[26]

The invention is also not limited to transferring an entire set of output data to a substitute apparatus. For example, in the ninth embodiment a supplementary destination apparatus can be selected according to the flowchart shown in Fig. 47. In the case of the ninth embodiment, a supplementary apparatus may be desirable in order to fulfill certain conditions set by a user that exceed the capabilities of a single apparatus, such as sorting 20 copies on a machine having only 10 sorting bins.[27] In such a situation, the invention as set forth in the ninth embodiment would allow the user to select a supplementary apparatus having 10 sorting bins, so the two apparatus together provide the necessary 20 sorting bins to fulfill the condition of sorting 20 copies set by the user.[28] The process includes a step of judging whether the apparatus is capable of carrying out the specified job alone.[29] If a judgment is made that the apparatus is not capable of carrying out the specified job alone, a layout diagram like the one shown in Fig. 26 is displayed, providing the user a display of icons representing an output apparatus that can be used as a supplementary apparatus.[30] An icon representing the closest apparatus capable of being used as a supplementary apparatus is automatically displayed in an inverted state.[31]

The tenth embodiment is similar to the ninth embodiment just described, except that in the tenth embodiment a supplementary apparatus is selected in order to meet a

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[25] *See Id.* at page 105, lines 12-22.

[26] *See Id.*

[27] *See Id.* at page 92, line 5 –page 93, line 2.

[28] *See Id.*

[29] *See Id.* at page 94, lines 11-14.

[30] *See Id.* at page 94, line 20 –page 95, line 18.

[31] *See Id.*

condition related to the amount of time it takes to perform a job, such as a copying job.[32] For example, if a single copy machine cannot perform a copying job within a prescribed amount of time, a process for allowing the user to set a supplementary copy machine to share the copy job can be performed.[33] This way, the two copy machine working together can perform the job within the prescribed time constraint.

Finally, the present invention is not limited to the layout diagram having icons. For example, the eleventh embodiment replaces that layout diagram of the first ten embodiments with a text-based dialog box shown in Fig. 50 having a system of lists and pull-down menus for the user to navigate in order to select a function and then an apparatus.[34] The twelfth embodiment has this type of text-based dialog box as well, shown in Fig. 52, but in this case the pull-down menus allow the user to navigate in order to select a user in the same manner as discussed above with regard to the seventh embodiment, where once a user is selected, a list of apparatuses used by the selected user is displayed as shown in Fig. 53.[35]

Issues

Issue 1 – Whether claims 9, 11, 12, 19-22, 25, 27, 33, 37-41, 56, 58, and 59 are patentable under 35 U.S.C. § 102(e) over U.S. Patent No. 5,809,265 to Blair et al. ("Blair")?

Issue 2 – Whether claims 14, 16, 17, 26, 34, and 35 are patentable under 35 U.S.C. § 103(a) over Blair in view of IBM Technical Disclosure Bulletin, "Methodology for Automated Printed Selection", Vol. 36, No. 09B, September 1993 to B.K. Jackson et al. ("Jackson")?

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[32] *See Id.* at page 98, lines 13-23.

[33] *See Id.* at page 94, line 14 –page 95, line 17.

[34] *See Id.* at page 106, lines 1-15.

[35] *See also Id.* at page 108, lines 13-20 and page 109, lines 7-21.

Issue 3 – Whether claims 10 and 13 are patentable under 35 U.S.C. § 103(a) over Blair in view of U.S. Patent No. 5,996,029 to Sugiyama et al. ("Sugiyama")?

Issue 4 – Whether claims 15 and 18 are patentable under 35 U.S.C. § 103(a) over Blair in view of Jackson, and further in view of Sugiyama?

Issue 5 – Whether claim 57 is patentable under 35 U.S.C. § 103(a) over Blair in view of Jackson?

Grouping of Claims

The claims of Issue 1, to the extent separately identified and argued below, do not stand or fall together.

The claims of Issue 2, to the extent separately identified and argued below, do not stand or fall together.

With respect to Issue 3 above, in order to make the appeal process as efficient as possible and for the purpose of this Appeal only, Appellants agree to have the claims of Issue 3 considered in a single group.

With respect to Issue 4 above, in order to make the appeal process as efficient as possible and for the purpose of this Appeal only, Appellants agree to have the claims of Issue 4 considered in a single group.

With respect to Issue 5 above, since only a single claim is at issue, no grouping is possible.

Argument

Issue 1 – Whether claims 9, 11, 12, 19-22, 25, 27, 33, 37-41, 56, 58, and 59 are patentable under 35 U.S.C. § 102(e) over Blair?

Claims 9, 25, 33, and 37

Each of independent claims 9, 25, 33, and 37 recites a step of classifying apparatuses into a plurality of categories with different functions and *displaying said categories* as items to be selected. Each of independent claims 9, 25, 33, and 37 also recites a step of displaying as items to be selected *only* input-output apparatuses classified in a category selected by a user.

Blair teaches a computer program wherein a map is displayed of a user-selected area, for example, of an office. Contrary to the invention of claims 9, 25, 33, and 37, Blair teaches displaying *all* of the input-output devices in the user-selected area on the map:

> One feature of the invention provides a system and method for allowing the users of a network to graphically select devices such as printers from a map of the building(s) that house the network.... In the illustrated embodiment, the close-ups have enough detail to show the offices and rooms of the wing. Further, the user can click on a button that represents *a printer or other output device,* such as a facsimile machine, modem, storage device, workstation, or other output device. The button has a title indicating the type of printer (e.g., high speed, color, etc.) and the button is located at the approximate corresponding position in the wing as the real printer.... Upon clicking on the button, a virtual connection is created between the end user's workstation and the one or more devices represented by the button(s).[36]

In other words, the Blair system displays devices, not display categories of devices. In fact, Blair is silent with regard to categorizing the output devices, particularly by function. Absent any teaching of categorizing of the devices and display of such categories, Blair cannot even suggest the additional step of displaying only certain devices that are in a category selected by a user.

Claims 11 and 12, dependent directly or indirectly from claim 9, are considered allowable by virtue of their dependencies.

Claims 19, 27 and 56

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[36] Blair, col. 2, lines 40-67 (emphasis added).

With respect to independent claims 19, 27 and 56, each of these claims recites a step of judging (or forming a judgment) whether a selected image forming apparatus is capable of carrying out printing (e.g., claims 19 and 27), or determining whether a selected printer is currently available (e.g., claim 56). Each of these claims also recites a step of displaying, when an outcome of said judgment indicates that the selected image forming apparatus is not capable of carrying out printing, installation locations of image forming apparatuses which are capable of printing to serve as a substitute (e.g., claims 19 and 27), or selecting a second printer automatically as a substitute output apparatus in response to the determination that the selected printer is not available (e.g., claim 56).

At one point, Blair mentions that a user can activate two virtual connections to respective output devices.[37] Blair discusses a setup where one of the virtual connections is designated as a "default device" to which the user's workstation management software automatically directs each print job. The second virtual connection is available to the user as a secondary printing source if for some reason the user decides to manually move a particular print job from the default printer's queue to this secondary printer's queue.

Thus, Blair teaches a system where a user connects to multiple printers and manually moves print jobs from print queue to print queue. This teaching contrasts the invention as recited in claims 19, 27 and 56, where a judgment is made as to whether the image forming apparatus can carry out printing, and, based on the results of that judgment, a display of locations of substitute image forming apparatuses is provided or a substitute apparatus is automatically selected. According to the teachings of Blair, not only is the user left on to manually check the status of each of the connected printers, but without any means for making a judgment of printing capability, the further step of selecting or displaying substitute printers is clearly outside the teachings of Blair.

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[37] See Blair, col. 5, lines 13-42.

Claims 38 and 41

With respect to independent claims 38 and 41, each of these claims recites a step of "displaying as items of selection the names of *users* regularly using said network system."[38] Each of claims 38 and 41 further recites "selecting one of names" and "displaying as items of selection only said input-output apparatuses associated with one of said users with the name thereof selected at said user name selecting step."

Blair is silent with regard to displaying names of users. Blair is silent with regard to providing for selecting one of some names displayed. Blair is silent with regard to displaying only input-output devices associated with a name that has been selected from a list of displayed names.

In setting forth the present rejection, the Examiner has asserted that Blair anticipates "displaying ...the names of users regularly using the network" based on the disclosure of Blair at col. 4, lines 54-67, reproduced below for convenience of review:

> As shown in FIGS. 3-4, a map 116 of an office building is displayed and the end user 113 can move a pointing device such as a mouse (not shown) around the map to display *the names 117 (e.g. Foothill Sierra 2 Bridge) of wings* 118 of the map 116. In this example, the mouse movement over a specific portion of the map 116 is sufficient to trigger the display of the name 117 of the portion 118 under the mouse. For example, FIG. 4 shows the effect of the end user positioning the mouse over the "Foothill Sierra 2 Bridge" *portion of the building.*
> In another example, FIG. 5 shows the end user selecting the "Foothill 2/2" *section 118 of the building* floor plan. Clicking on the mouse to effectuate this selection results in the display of a wing level map 119 of the selected section 118, in this case "Foothill 2/2," as shown in FIG. 6. At this level the user can see the floor plan of the wing, including individual offices, such as office 120.[39]

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[38] Emphasis added.

[39] Blair, col. 4, lines 51-67 (emphasis added).

Specifically, the present Office Action states "Blair et al. teach ...a user name (118, column 4, lines 54-67) displaying step for displaying as items of selection the names of users (the name of the system located in foothill 2/2)...."[40] It is then argued in the present Office Action that:

> The system located at Foothill Sierra 2 Bridge is using a network system for communication. (Column 1, and column 2, lines 40-45, Blair) Therefore, Foothill Sierra 2 Bridge is a name representing a group of users using the network system for communications.[41]

Applicants respectfully disagree. There is simply no clear basis for the above line of reasoning based on the disclosure of Blair. Nowhere does Blair refer to "Foothill Sierra 2 Bridge" as a name for a group of users or provide any context for inferring that "Foothill Sierra 2 Bridge" is a name of a group of users. Blair only uses the titles such as "Foothill Sierra 2 Bridge" for referring to a portion or section of a building.

On the other hand, it seems apparent that the above line of reasoning reproduced from the present Office Action is wholly based on knowledge gleaned from the present invention. In other words, the rejection of claims 38 and 41 is based on impermissible hindsight. Blair simply fails to disclose displaying user names, and therefore cannot anticipate claims 38 and 41.

Issue 2 – Whether claims 14, 16, 17, 26, 34, and 35 are patentable under 35 U.S.C. § 103(a) over Blair in view of Jackson?

Claims 14, 16, and 17

Independent claim 14 recites a step of classifying input-output apparatuses into a plurality of categories with different pieces of user identification and displaying as items of selection pieces of user identification.

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[40] Office Action, page 5, lines 3-8 (Dec. 18, 2002).

[41] *Id.* at page 16, lines 5-8.

As acknowledged in the present Office Action, Blair does not teach classifying input-output apparatuses according to pieces of user identification information. Neither does Jackson. Jackson teaches correlating a user's *physical location* with a terminal ID, not the group of printers. Specifically, Jackson recites:

> The Selector Service calls upon a Directory Service to correlate the user's terminal ID with it's predefined *physical location*.[42]

Blair teaches displaying printers based on a physical location of the printers on a map. Jackson allows the user to enter a terminal ID, where Blair provided a map selector, as a basis of determining the proper physical location. Thus, combining Blair and Jackson teaches displaying/categorizing according to physical location. This is in contrast to the invention as defined by claim 9 which involves categorizing/displaying according to user identification.

It stands to reason that, since the combination of Blair and Jackson fails to teach displaying pieces of user identification, the combination of Blair and Jackson also cannot teach displaying input-output apparatuses in a category corresponding to thus displayed user id information selected by a user as recited by claim 14.

Claim 26

With respect to claim 26, it is respectfully submitted this claim recites similar features as claim 14, and therefore patentably distinguishes over the combination of Blair and Jackson for similar reasons as those discussed in connection with claim 14. For example, claim 26 recites:

> a step for displaying said user identification codes on a display as items to be selected; and
> a step for displaying on said display as items to be selected only said input-output apparatuses cataloged in one of said groups identified by one of said user identification codes selected by the user.

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[42] Jackson, lines 21-22 (emphasis added).

Just as the combination of Blair and Jackson are silent with regard to "displaying...pieces of user identification information...," the combination of Blair and Jackson is also silent with regard to "displaying...user identification codes on a display as items to be selected." Further, just as there is no suggestion or motivation, anywhere in the combination of Blair and Jackson, for displaying input-output apparatuses in a category corresponding to thus displayed user ID information selected by a user, there is also no suggestion or motivation, anywhere in the combination of Blair and Jackson, for displaying "as items to be selected only said input-output apparatuses cataloged in one of said groups identified by one of said user identification codes selected by the user."

Claims 34 and 35

With respect to claims 34 and 35, it is respectfully submitted that the subject matter claimed in each of these claims patentably distinguishes over Blair in view of Jackson. Each of these claims depends from claim 33, addressed above, and therefore incorporates all of the limitations of claim 33. As discussed above, claim 33 patentably distinguishes over Blair. In that discussion, it was pointed out that Blair provides for the display of output devices according to their location on a map. However, Blair is not concerned with classifying the output devices into plural categories with different functions, and accordingly provides no teaching related to displaying such categories as items for selection. The proposed combination adds to Blair the disclosure of Jackson, which is concerned with providing a user with a list of printers in a user's immediate area. Thus, Jackson serves only to reinforce the concept introduced in Blair of providing displaying printers according to their physical location. Accordingly, Blair in view of Jackson provides no teaching that would suggest the idea of, or motivate one skilled in the art to consider, "classifying ...input-output apparatuses into a plurality of categories having different functions and displaying said categories on a display as items to be selected" as set forth in claim 33 and by reference in claims 34 and 35.

Claim 33 further recites "displaying ...only said input-output apparatuses corresponding to one of said categories displayed at said first step." As pointed out above, Blair in view of Jackson fails to suggest even classifying output devices according to such

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categories, let alone displaying such categories. With no suggestion in Blair in view of Jackson of providing a display of such categories as items to be selected, it follows that Blair in view of Jackson cannot suggest to one skilled in the art the step of displaying input-output apparatuses corresponding to one of such categories as set forth in claim 33 and thus by reference in each of claims 34 and 35.

Still further, claim 33 recites "specifying as an input-output destination an input-output apparatus selected from said input-output apparatuses displayed at said second step." As pointed out above, Blair in view of Jackson fails to suggest classifying input-output apparatuses into categories with different functions. As there is no suggestion in Blair in view of Jackson of even creating such categories, it can be immediately appreciated that there is no suggestion in Blair in view of Jackson for displaying such categories. It, therefore, can also be immediately appreciated that there is also no suggestion in Blair in view of Jackson for displaying apparatuses in only one of such categories. Finally, it should be apparent that Blair in view of Jackson fails to suggest specifying an input-output apparatus selected from those displayed in the one such category. Since Blair in view of Jackson fails to suggest all of the limitations of claim 33, and fails to provide motivation for one skilled in the art to modify anything disclosed in Blair in view of Jackson to arrive at the invention as recited in claim 33, Blair in view of Jackson cannot render obvious claim 33, or claims 34 and 35 which depend from claim 33.

Issue 3 – Whether claims 10 and 13 are patentable under 35 U.S.C. § 103(a) over Blair in view of Sugiyama?

With respect to claims 10 and 13, it is respectfully submitted that the subject matter claimed in each of these claims patentably distinguishes over Blair in view of Sugiyama. Each of these claims depends from claim 9, addressed above. In that discussion, it was pointed out that Blair provides for the display of output devices according to their location on a map. However, Blair is silent with regard to categorizing the output devices, particularly by function, and accordingly provides no teaching related to displaying such categories as items for selection. The proposed combination adds to Blair the disclosure of Sugiyama. The present Office Action alleges that Sugiyama discloses displaying

information indicating whether each of a plurality of input-output apparatuses is usable. However, even if, for the sake or argument, this allegation were true, and such disclosure was to be combined with the teaching of Blair, the proposed combination would still fail to suggest classifying the output devices into plural categories according to their functionality, and would also further still fail to suggest displaying such categories as items for selection. Thus, the proposed combination of Blair in view of Sugiyama fails to teach or suggest all of the limitations of claim 9, or claims 10 and 13 which depend from claim 9.

Issue 4 -- Whether claims 15 and 18 are patentable under 35 U.S.C. § 103(a) over Blair in view of Jackson, and further in view of Sugiyama?

With respect to claims 15 and 18, it is respectfully submitted that the subject matter claimed in each of these claims patentably distinguishes over Blair in view of Jackson, and further in view of Sugiyama. Each of these claims depends, directly or indirectly, from claim 14, addressed above. In that discussion, it was pointed out that Blair in view of Jackson fails to suggest displaying input-output apparatuses in a category corresponding to thus displayed user identification information selected by a user as recited by claim 14. The proposed combination adds to the combination of Blair and Jackson the disclosure of Sugiyama. The present Office Action alleges that Sugiyama discloses displaying information indicating whether each of a plurality of input-output apparatuses is usable. However, even if, for the sake or argument, this allegation were true, and such disclosure was to be combined with the teaching of Blair in view of Jackson, the proposed combination of Blair, Jackson, and Sugiyama would still fail to suggest displaying input-output apparatuses in a category corresponding to thus displayed user identification information selected by a user as recited by claim 14. Thus, the proposed combination of Blair in view of Sugiyama fails to teach or suggest all of the limitations of claim 14, or claims 15 and 18 which depend from claim 14.

Issue 5 – Whether claim 57 is patentable under 35 U.S.C. § 103(a) over Blair in view of Jackson?

With respect to claim 57, it is respectfully submitted that the subject matter claimed in this claim patentably distinguishes over Blair in view of Jackson. Claim 57 depends from claim 56 and therefore incorporates all of the limitations of claim 56. As discussed above, claim 56 patentably distinguishes over Blair. In that discussion, it was pointed out that Blair provides for a user to activate two virtual connections to respective output devices, where one of the virtual connections is designated as a "default device" to which the user's workstation management software directs each print job, and the user can manually redirect print jobs if he so desires. Blair does suggest making any kind of determinations as to printer availability.

The present rejection combines with Blair the disclosure of Jackson, which is related to providing a user with a list of printers in a user's immediate area, including a recommendation of a "best capable printer". Jackson discusses making a determination of this capability based on "object attributes" correlating to a "user's terminal ID". Thus, in Jackson, the recommendation relates to matching attributes of business machines. However, Jackson is silent with regard to making a recommendation based on **availability**. Therefore, if one skilled in the art were to combine Blair and Jackson, the resulting combination would still fail to suggest "determining whether [a] first printer is currently available" and "selecting a...printer automatically...as a substitute output apparatus in response to the determination that said first printer is not available" as recited in claim 56. Thus, the proposed combination of Blair in view of Jackson fails to teach or suggest all of the limitations of claim 56, or claim 57 which depend from claim 56.

Conclusion

In view of the foregoing, a *prima facie* case of obviousness has not been established with regard to claims 1-8. Accordingly, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the Examiner's rejections as to all of the appealed claims.

Respectfully submitted,

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APPENDIX

9. (Previously Amended) A machine readable medium on which is recorded a program for selecting a desired input-output apparatus from a plurality of input-output apparatuses connected to a network, said program comprising:

a first display step for classifying said input-output apparatuses into a plurality of categories with different functions and displaying said categories on a display as items to be selected; and

a second display step for displaying on said display as items to be selected only said input-output apparatuses classified in a category selected by a user.

10. (Previously Amended) A machine readable medium according to claim 9, wherein said second display step includes a sub-step for displaying on said display information indicating whether or not each respective one of said input-output apparatuses is usable.

11. (Previously Amended) A machine readable medium according to claim 9, wherein said second display step further includes a sub-step for displaying on said display a map of said network with symbolic marks of said input-output apparatuses on said map, with each symbolic mark representing an installation location of respective ones of said input-output apparatuses.

12. (Previously Amended) A machine readable medium according to claim 11, wherein said program further includes a step for setting as an apparatus to be used one of said input-output apparatuses represented by one of said symbolic marks as selected by a user.

13. (Previously Amended) A machine readable medium according to claim 11, wherein said second display step further includes a sub-step for displaying on said display at locations in close proximity to each one of said symbolic marks representing said input-

output apparatuses information indicating whether or not each of said input-output apparatuses is usable.

14.   (Previously Amended) A machine readable medium on which is recorded a program for selecting a desired input-output apparatus from a plurality of input-output apparatuses connected to a network, said program comprising:

a first display step for classifying said input-output apparatuses into a plurality of categories with different pieces of user identification information and for displaying on a display as items of selection said pieces of user identification information; and

a second display step for displaying on said display as items of selection only said input-output apparatuses in a category corresponding to a thus displayed user identification information which is selected by a user.

15.   (Previously Amended) A machine readable medium according to claim 14, wherein said second display step further includes a sub-step for displaying on said display information indicating whether or not each of said input-output apparatuses is usable.

16.   (Previously Amended) A machine readable medium according to claim 14, wherein said second display step further includes a sub-step for displaying on said display a map of said network with symbolic marks of said input-output apparatuses on said map, with each symbolic mark representing an installation location of respective ones of said input-output apparatuses.

17.   (Previously Amended) A machine readable medium according to claim 16, wherein said program further includes a step for setting as an apparatus to be used one of said input-output apparatuses represented by a corresponding one of said symbolic marks as selected by a user.

18.   (Previously Amended) A machine readable medium according to claim 16, wherein said second display step further includes a sub-step for displaying on said display at locations in close proximity to each one of said symbolic marks representing said image

forming apparatuses information indicating whether or not each of said input-output apparatuses is usable.

19. (Previously Amended) A machine readable medium on which is recorded a program for selecting a desired image forming apparatus from a plurality of image forming apparatuses connected to a network, said program comprising:

a select step for selecting as an output destination one of said image forming apparatuses designated by a user;

a judgment step for judging whether or not said image forming apparatus set at said select step is capable of carrying out printing; and

a display step for displaying on a display, when an outcome of said judgment formed at said judgment step indicates that said image forming apparatus set at said select step is not capable of carrying out printing, installation locations of said image forming apparatuses which are capable of carrying out printing to serve as a substitute for said image forming apparatus set at said select step.

20. (Previously Amended) A machine readable medium according to claim 19, wherein said display step further includes a sub-step for displaying on said display a map of said network with symbolic marks of said image forming apparatuses on said map, with each symbolic mark representing an installation location of respective ones of said image forming apparatus.

21. (Previously Amended) A machine readable medium according to claim 20, wherein said program further includes a step for setting as an output destination an image forming apparatus represented by a corresponding one of said symbolic marks selected by the user.

22. (Previously Amended) A machine readable medium according to claim 19, wherein said display step further includes a sub-step for displaying on said display characters describing the name of each of said image forming apparatuses and characters describing a location at which each of said image forming apparatuses is installed.

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25. (Previously Amended) An input-output apparatus selecting method for selecting a desired input-output apparatus from a plurality of input-output apparatuses connected to a network system, said input-output apparatus selecting method comprising:

a step for classifying said input-output apparatuses connected to said network system into a plurality of categories with different functions and for displaying said categories on a display as items to be selected; and

a step for displaying on said display as items to be selected only said input-output apparatuses classified in a category selected by the user.

26. (Previously Amended) An input-output apparatus selecting method for selecting a desired input-output apparatus from a plurality of input-output apparatuses connected to a network system wherein said apparatuses are cataloged by classifying said apparatuses into groups identified by user identification codes, said input-output apparatus selecting method comprising:

a step for displaying said user identification codes on a display as items to be selected; and

a step for displaying on said display as items to be selected only said input-output apparatuses cataloged in one of said groups identified by one of said user identification codes selected by the user.

27. (Previously Amended) An image forming apparatus selecting method for selecting a desired image forming apparatus from a plurality of image forming apparatuses connected to a network system, said image forming apparatus selecting method comprising:

a select step for setting as an output destination one of said image forming apparatuses selected by a user;

a judgment step for forming a judgment as to whether or not said image forming apparatus set at said select step is capable of carrying out printing; and

a display step for displaying on a display, when an outcome of said judgment formed at said judgment step indicates that said image forming apparatus set at said select step is not capable of carrying out printing, installation locations of said image forming

a step for displaying a low level image or a low level table on another one of said layers at a level immediately lower than said high level in said hierarchical structure wherein said low level image or said low level table is determined by an item selected from said items of selection shown in said high level image or said high level table.

37. (Previously Amended) An input-output apparatus specifying method to be adopted in a network system for connecting a plurality of computers and a plurality of input-output apparatuses, said input-output apparatus specifying method comprising:

a category displaying step for classifying said input-output apparatuses into a plurality of categories with different functions and for displaying said categories on a display as items to be selected;

an apparatus displaying step for displaying on said display as items to be selected only those input-output apparatuses in a category selected from said categories displayed at said category displaying step; and

an apparatus specifying means for selecting a desired one of said input-output apparatuses displayed at said apparatus displaying step and for specifying as an input-output destination said selected input-output apparatus.

38. (Previously Amended) A machine readable medium on which is recorded a program for a network system connecting a plurality of computers and a plurality of input-output apparatuses, said program comprises:

a user name displaying step for displaying as items of selection the names of users regularly using said network system;

a user name selecting step for selecting one of said names displayed at said user name displaying step;

an input-output apparatus displaying step for displaying as items of selection only said input-output apparatuses associated with one of said users with the name thereof selected at said user name selecting step; and

an input-output apparatus selecting step for selecting as an input-output destination a desired one of said input-output apparatuses displayed at said input-output apparatus displaying step.

39.   (Previously Amended) A machine readable medium according to claim 38, wherein said user name displaying step further includes a sub-step for displaying the names of said users on a layout diagram along with icons each representing one of said input-output apparatuses.

40.   (Previously Amended) A machine readable medium according to claim 38, said program further includes:

a step for creating a plurality of images or tables each showing installation locations of said input-output apparatuses on layers at different levels forming a hierarchical structure;

a step for displaying a high level image or a high level table on one of said layers at a high level in said hierarchical structure wherein said high level image or said high level table shows items of selection; and

a step for displaying a low level image or a low level table on another one of said layers at a level immediately lower than said high level in said hierarchical structure wherein said low level image or said low level table is determined by an item selected from said items of selection shown in said high level image or said high level table.

41.   (Previously Amended) An input-output apparatus specifying method to be adopted in a network system for connecting a plurality of computers and a plurality of input-output apparatuses, said input-output apparatus specifying method comprising:

a user name displaying step for displaying as items of selection the names of users regularly using said network system;

a user name selecting step for selecting one of said names displayed at said user name displaying step;

an input-output apparatus displaying step for displaying as items of selection only said input-output apparatuses associated with one of said users with the name thereof selected at said user name selecting step; and

an input-output apparatus selecting step for selecting as an input-output destination a desired one of said input-output apparatuses displayed at said input-output apparatus displaying step.

apparatuses which are capable of carrying out printing to serve as a substitute for said image forming apparatus set at said select step.

33.   (Previously Amended) A machine readable medium on which is recorded a program written for a network system to which a plurality of input-output apparatuses and a plurality of computers are connected, said program comprising:

a first step for classifying said input-output apparatuses into a plurality of categories having different functions and displaying said categories on a display as items to be selected;

a second step for displaying on said display as items to be selected only said input-output apparatuses corresponding to one of said categories displayed at said first step; and

a third step for specifying as an input-output destination an input-output apparatus selected from said input-output apparatuses displayed at said second step.

34.   (Previously Amended) A machine readable medium according to claim 33, wherein said program further comprises:

a step for displaying on said display a layout image representing locations of said input-output apparatuses;

a step for displaying icons as items of selection over said layout image displayed on said display, each icon representing one of said input-output apparatuses at locations corresponding to actual installation locations of said input-output apparatuses; and

a step for selecting as an input-output destination one of said input-output apparatuses represented by an icon selected from said icons.

35.   (Previously Amended) A machine readable medium according to claim 33, wherein said program further comprises:

a step for creating a plurality of images or tables each showing installation locations of said input-output apparatuses on layers of different levels forming a hierarchical structure and storing said hierarchical structure;

a step for displaying a high level image or a high level table on one of said layers at a high level in said hierarchical structure wherein said high level image or said high level table shows items of selection; and

56. (Previously Added) A program that can be read by a computer which has a computer execute the steps of:

selecting a first printer, as an output destination of image data, from among a plurality of printers connected to a network;

determining whether said first printer is currently available or not; and

selecting a second printer automatically, from a plurality of printers connected to a network, as a substitute output apparatus in response to the determination that said first printer is not available.

57. (Previously Added) A program according to claim 56, wherein said second printer selected as a substitute output apparatus is located in closest proximity to the user.

58. (Previously Added) A program according to claim 56, wherein said second printer selected as a substitute output apparatus exceeds said first printer in function.

59. (Previously Amended) A program according to claim 56, wherein said second printer selected as a substitute output apparatus exceeds said first printer in printing speed.

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